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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/492,954	01/27/2000	Anna Marie Pyle	58077/JPW/JSG	1593

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EXAMINER

WHISENANT, ETHAN C

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 02/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/492,954

Applicant(s)

PYLE ET AL.

Examiner

Ethan Whisenant, Ph.D.

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 January 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 22 November 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-8.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: The applicant's After Final response has been entered.

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ADVISORY ACTION

1. The applicant's Response (filed 22 JAN 04) to the Final Office Action has been received and considered. The applicant's response has been entered, however, the Claim rejections have been maintained for the reason(s) outlined below.

RESPONSE TO APPLICANT'S AMENDMENT/ ARGUMENTS

2. Applicant's arguments with respect to the claimed invention have been fully and carefully considered but are not deemed to be persuasive.

To begin, the applicant traverses the **Rejection of Claims 1-5 and 7-8** under 35 USC 103(a) as being unpatentable over Shuman (1992) in view of Bjornson et al. (1994), arguing that the Examiner has failed to establish a *prima facie* case of obviousness. The applicant argues that this combination fails to provide a reasonable expectation of success and fails to provide the requisite motivation to combine.

As regards the reasonable expectation of success the applicant correctly points out that there are well known differences between DNA and RNA and state that "it is undisputed that RNA and DNA are chemically distinct molecules having certain distinct properties." The applicant fails to take note that while there are well known differences between DNA and RNA, it was equally well known at the time of the invention how these distinct molecules with certain distinct properties will perform in biochemical assays. With that knowledge at the time of the invention, the examiner asserts that it would have been simple to predict how the molecules would perform in a biochemical reaction and provide the ordinary artisan with a reasonable expectation of success in the combination of Shuman in view of Bjornson et al.

As regards, the motivation to combine the examiner (Arun Chakrabarti) clearly set out the motivation to combine in para 2, pages 4-5 of the Final Action. Please note that the previous examiner of this application (Arun Chakrabarti) has now left the office. The current examiner is Ethan Whisenant.

Furthermore, it must be pointed out that the combination set out by the examiner to reject Claims 1-5 and 7-8, when boiled down to its essential point, is simply using the detection methodology of Bjornson et al. in the method of Shuman. It is the substitution of one well known method of detection for a second equally well known method of detection. Please note that in the absence of an unexpected result, the substitution of one well known method/reagent with known properties for a second well known

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method/reagent with well known properties would have been *prima facie* obvious to the ordinary artisan at the time of the invention. As regards the motivation to make the substitution recited above, the motivation to combine arises from the expectation that the prior art elements will perform their expected functions to achieve their expected results when combined for their common known purpose. Support for making this obviousness rejection comes from the M.P.E.P. at 2144.07 and 2144.09.


The applicant also traverses the **Rejection of Claim 6** under 35 USC 103(a) as being unpatentable over Shuman (1992) in view of Bjornson et al. (1994) as applied against Claim 1 and further in view of Vargo et al. (2001), arguing that the portion of Vargo et al. relied on by the examiner fails to provide the requisite motivation to combine the references cited. On this point the current examiner agrees. However, the current examiner would like to point out that Vargo et al. do make it clear that the labels fluorescein isothiocyanate and rhodamine isothiocyanate were well known at the time of the invention, as was their use in biochemical assays.

Again, the applicant should note that the substitution of one well known method/reagent with known properties for a second well known method/reagent with well known properties would have been *prima facie* obvious to the ordinary artisan at the time of the invention in the absence of an unexpected result. As regards the motivation to make the substitution recited above, the motivation to combine arises from the expectation that the prior art elements will perform their expected functions to achieve their expected results when combined for their common known purpose. Support for making this obviousness rejection comes from the M.P.E.P. at 2144.07 and 2144.09.

CONCLUSION

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ethan Whisenant, Ph.D. whose telephone number is (571) 272-0754. The examiner can normally be reached Monday-Friday from 8:30AM -5:30PM EST or any time via voice mail. If repeated attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion, can be reached at (571) 272-0782.

The fax number for this Examiner is (571) 273-0754. Before faxing any papers please inform the examiner to avoid lost papers. Please note that the faxing of papers must conform with the Notice to Comply published in the Official Gazette, 1096 OG 30 (November 15, 1989).


ETHAN WHISENANT
PRIMARY EXAMINER
Art Unit 1634